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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
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10/566,646

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Mitsunobu Suda

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08/19/2008

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EXAMINER

HINZE, LEO T

ART UNIT

PAPER NUMBER

2854

MAIL DATE

DELIVERY MODE

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PAPER

Please find below and/or attached an Office communication concerning this application or proceeding.

The time period for reply, if any, is set in the attached communication.

Office Action Summary	Application No. 10/566,646	Applicant(s) SUDA, MITSUNOBU	
	Examiner LEO T. HINZE	Art Unit 2854	

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☒ Responsive to communication(s) filed on 01 May 2008.
- 2a) ☐ This action is **FINAL**. 2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) ☒ Claim(s) 12-29 is/are pending in the application.
- 4a) Of the above claim(s) 16-18 and 21-29 is/are withdrawn from consideration.
- 5) ☐ Claim(s) _____ is/are allowed.
- 6) ☒ Claim(s) 12-15, 19 and 20 is/are rejected.
- 7) ☐ Claim(s) _____ is/are objected to.
- 8) ☐ Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☒ The drawing(s) filed on 30 March 2006 is/are: a) ☒ accepted or b) ☐ objected to by the Examiner.
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. § 119

- 12) ☒ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☒ All b) ☐ Some * c) ☐ None of:
1. ☒ Certified copies of the priority documents have been received.
2. ☐ Certified copies of the priority documents have been received in Application No. _____.
3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

* See the attached detailed Office action for a list of the certified copies not received.

Attachment(s)

- | | |
|--|---|
| 1) <input checked="" type="checkbox"/> Notice of References Cited (PTO-892) | 4) <input type="checkbox"/> Interview Summary (PTO-413) |
| 2) <input type="checkbox"/> Notice of Draftsperson's Patent Drawing Review (PTO-948) | Paper No(s)/Mail Date. _____ |
| 3) <input checked="" type="checkbox"/> Information Disclosure Statement(s) (PTO/SB/08) | 5) <input type="checkbox"/> Notice of Informal Patent Application |
| Paper No(s)/Mail Date <u>20060201</u> . | 6) <input type="checkbox"/> Other: _____ |

DETAILED ACTION

Priority

1. Receipt is acknowledged of papers submitted under 35 U.S.C. 119(a)-(d), which papers have been placed of record in the file.

Election/Restrictions

2. Applicant's election with traverse of claims 12-15, 19, and 20 in the reply filed on 01 May 2008 is acknowledged. The traversal is on the ground(s) that the examiner has failed to establish a lack of unity of invention, and therefore the restriction requirement is improper. This is not found persuasive because the evidence in the record, particularly the ISR from PCT/JP04/13726, cites "Y" references which establish an *a posteriori* lack of unity of the invention, by showing that the technical features of independent claim 12 lack an inventive step with respect to the prior art, and therefore do not define a special technical contribution over the prior art. See ISPE 10.02-10.036, and PCT Rule 13.2.

The requirement is still deemed proper and is therefore made FINAL.

Claim Rejections - 35 USC § 112

3. Claims 15 and 20 are rejected under 35 U.S.C. 112, second paragraph, as being indefinite for failing to particularly point out and distinctly claim the subject matter which applicant regards as the invention.

Claims 15 and 20 recite the limitation that "said damper member is constructed in a substantially same shape as said collar." This limitation is indefinite, because "shape"

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can be difficult to define with respect to a part, particularly the claimed collar, which itself is a part of a larger piece. This makes it difficult to determine which portion of the larger piece is the collar, and hence, what the shape of the collar is. It appears from the other limitations in the claim, particularly "a collar having a plane parallel to a direction perpendicular to the stamping direction" that the Applicant intends to claim a relationship between the noted plane on the collar, and a corresponding plane on the damper member.

To expedite prosecution, the examiner will interpret the claim as reciting that the collar and damper have mating surfaces that are similarly shaped.

Appropriate correction and/or clarification is required.

Claim Rejections - 35 USC § 103

4. The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

5. Claims 12-15, 19, and 20 are rejected under 35 U.S.C. 103(a) as being unpatentable over Hiraga et al., US 4,970,952 A (hereinafter Hiraga) in view of Bengtsson, US 4,858,526 A (hereinafter Bengtsson).

a. Regarding claim 12:

Hiraga teaches a stamp comprising: a first face (25, Fig. 2); a second print face for forming a print image on said stamping object by synthesizing with the print image of

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said first print face (10, Fig. 2); and a damper member that presses said first print face so that said first print face in a stamping direction is projected more than said second print face in the stamping direction with elasticity at the time of no stamping and is compressed so that said first print face and said second print face are matched with each other with a reaction force applied to said first print face from said stamping object at the time of stamping (damper member 25a keeps the first face proud of the second until compressed, when first and second faces are even and second face produces a print, Fig. 2).

Hiraga does not teach wherein the first face is a first print face for forming a print image on a stamping object.

Bengtsson teaches a first print face for forming a print image on a stamping object (3, Fig. 6); a second print face for forming a print image on said stamping object by synthesizing with the print image of said first print face (20, Fig. 3); and wherein said first print face and said second print face are matched with each other at the time of stamping (both faces stamp an image on the substrate, col. 2, ll. 44-48). The first print face is advantageous for printing the name of a company or the designation of a place (col. 2, ll. 45-46), and the second for printing a date (col. 2, l. 48).

It would have been obvious to a person having ordinary skill in the art at the time the invention was made to modify Hiraga such that the first face is a first print face for forming a print image, as taught by Bengtsson, because one having ordinary skill in the art would recognize that this combination would predictably allow the device of Hiraga to

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print additional information, such as the name of a company or the designation of a place.

b. Regarding claim 13, the combination of Hiraga and Bengtsson teaches the stamp according to claim 12, as discussed in the rejection of claim 12 above. The combination of Hiraga and Bengtsson also teaches wherein a length over which said damper member is capable of stretching in the stamping direction when not compressed is larger than a length over which said first print face is projected with respect to said second print face at the time of no stamping (Hiraga: the spring 25a, when not compressed, extends first face 25 beyond second face 10, and when compressed, allows second face 10 to be even with first face 25, Fig. 2; col.3, ll. 40-50).

c. Regarding claims 14 and 19, the combination of Hiraga and Bengtsson teaches the stamp according to claims 13 and 12, respectively, as discussed in the rejection of claims 13 and 12 above. The combination of Hiraga and Bengtsson also teaches a movable print body fixed on a main body case and in which a plurality of said second print faces are provided protrudedly along the outside face of a belt supported movably (Hiraga: 10, Fig. 2); and a fixed print body provided movably in the stamping direction with respect to the main body case (Bengtsson, 3, Fig. 1), having an exposure hole (Hiraga: 25b, Fig. 2) for exposing one of said second print faces of said movable print body out of the main body case and having said first print face for forming a single print image by synthesizing with a print image of said second print face exposed from the exposure hole, wherein said damper member is provided between said movable print

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body and said fixed print body such that it always keeps contact therewith (Hiraga: damper 25a is between first face 25 and movable print body 10, Fig. 2).

d. Regarding claims 15 and 20, the combination of Hiraga and Bengtsson teaches the stamp according to claims 14 and 19, respectively, as discussed in the rejection of claims 14 and 19 above. The combination of Hiraga and Bengtsson also teaches wherein said movable print body has a collar having a plane parallel to a direction perpendicular to the stamping direction at a portion that said damper member makes contact with (Hiraga: body 1 has unlabeled collar portion in contact with upper part of spring 25a, Fig. 2) and said damper member is constructed in a substantially same shape as said collar (Hiraga: spring 25a has a “shape” that corresponds to the “shape” of unlabeled collar, and these corresponding “shapes” allow damper and collar to effectively move the second print face into alignment with the first face).

Conclusion

6. Any inquiry concerning this communication or earlier communications from the examiner should be directed to Leo T. Hinze whose telephone number is 571.272.2864. The examiner can normally be reached on M-F 8-5.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Judy Nguyen can be reached on 571.272.2258. The fax phone number for the organization where this application or proceeding is assigned is 571-273-8300.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR.

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Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free). If you would like assistance from a USPTO Customer Service Representative or access to the automated information system, call 800-786-9199 (IN USA OR CANADA) or 571-272-1000.

/Anthony H Nguyen/
Primary Examiner, Art Unit 2854

Leo T. Hinze
Patent Examiner
AU 2854
12 August 2008